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EXAMINER ZURITA, JAMES H				
ART UNIT		PAPER NUMBER		
3625				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/883,933

Applicant(s)

ATTIA, OLIVIER

Examiner

JAMES ZURITA

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 01/21/2009 has been entered.

Priority

Applicant claims priority to provisional application 60/212575, filed 06/20/2000.

Claims 20-34 are drawn to materials found in para 0094-0108, introduced in the instant application on 06/20/2001.

The effective filing date for these features is 06/20/2001.

Response to Amendment

On 01/21/2009, applicant amended claims 20, 22, 24, 25, 27, 29, 30, 32 and 34.

Claims 20-34 are pending and will be examined.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, the catalog, substitute table, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 24, 29 and 34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Applicant argues that claim 20 recites "...at least two ways..." that a substitute product can be found. Claim 24 appears to add another way, i.e., by "...querying at least one [external? Internal?] code registry..."

Response to Arguments

Applicant's arguments filed 01/21/2009 have been fully considered but they are not persuasive.

Applicant argues, in response to rejections under 35 USC 112,

Claim 20 recites at least two ways that a substitute product can be found.

The first way is by "determining whether a substitute product is indicated in a substitute table." Only if this first way fails, is the second way attempted.

The second is "searching for at least one substitute product in the product database by comparing attributes of the first product to attributes of products in the product database."

Thus, a substitute product can be a substitute product without being in the substitute table. That is, such a substitute product can be found by "searching for at least one substitute product in the product database by comparing attributes of the first product to attributes of products in the product database," as recited in claim 20.

In response, the Examiner notes that claim 20, as written, precludes executing search for a substitute product when a product is determined to be available by finding the product's UPC code in the product database. Further, the limitations are take place only if the UPC code is not found in the products database. See also rejection under 35 USC 112, "...determining that a product is available..."

[0110] In case of SKUs and SBCs, matching records would be found if valid SKUs or SBCs have been entered; and there is no question of ScanFind coming into operation. In case of UPC, the processes as described in previous paragraphs—since the

ScanFind will be activated only if the UPC code were not found in the Products Database.

The Examiner also notes that applicant also claims an alternate way of finding a substitute product, that is, by searching a code registry, as in claims 24, 29 and 34.

Applicant argues,

Adding the approved substitute to the substitute table avoids, e.g., the issue of having to search through the product database in the future if the same unavailable product is requested again.

In response, the above limitations are not claimed. The claims recite:

response to the approval, saving the approved substitute product in a shopping cart of the customer and adding the approved substitute product to the substitute table such that a future check of the substitute table for the first product would indicate the approved substitute product.

Applicant has dropped his arguments concerning limitation (i), pages 9-10 of 09/20/2008, copied below for applicant's convenience:

Attorney Docket No. 0290836-00135 US1

Applicant respectfully submits that claim 26 should be interpreted to include all limitations and respectfully requests that the Examiner reconsider the claim to include the limitation not considered, namely, "if said first product is determined not to have a substitute indicated in the substitute table, searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 20, 25 and 30, it is not clear what is being claimed:

e ...in response to [action?] a barcode of said plurality of barcodes in the catalog being scanned by the customer.

Claims 20, 21, 25, 26, 30 and 31 refer to "...catalog..." and to "...customer catalog..." which appear to be the same item. However, there is no mention of catalog in provisional application 60/212575, while the instant application refers only to:

...A customer, who has already registered at the Aggregator Website, scans the barcode of the desired product from a **catalog**, magazine, or product packaging using a handheld scanner. These barcodes first get stored in the scanner memory. After logging into his/her Account on the Aggregator Website, the User uploads the entire list (of barcodes scanned) to ...[para 0006]

[original claim] 1. The system and method comprises the following steps: uploading barcodes in using a personal scanner into a centralized repository, resolving this barcode into appropriate product identification (such as the SKU), storing this information in the repository in the form of customized shopping lists or folders, using these lists to conduct online shopping, creating or printing personalized **catalogs** that include the product information of items within these shopping lists along an associated barcode.

For purposes of examination, catalog is given its broadest reasonable interpretation to include a list, directory, file, index. Prior art is interpreted to disclose a catalog where prior art discloses a list of product identifiers.

Claims 20, 25 and 30 refer to "...determining that a product is available..." and it is not clear how availability is determined. It is also not clear what the difference is between "Sold Out i.e. Not in Stock" (para 0095) and out of stock (para 0104, claim 23).

[0095] "ScanFind" is a component of the ScanCommerce System that will seek Substitutes for products that are either "Not Sold" or "Sold Out i.e. Not in Stock". This Component, essentially, tries to identify the product details from the UPC Code of the product that User wishes to buy; and if this product is not found in the Products Repository, compares the details of this product with the details of products available in

the Product Repository; and if they match, record the product in the Repository as a Substitute of the original product searched for.

[0104] ScanFind can also be used for another purpose. Some products may go out of stock when a User attempts to place an Order using a Shopping Cart that has been saved for a considerable period of time. During such cases, it is important to prompt the User that s/he may wish to buy a substitute as it may take time to fulfill the order for the original product. The ScanFind component that checks whether the product has gone out of stock; and if so, recommends the substitute. [emphasis added]

Determining that a product is available also is described in para 0010, which seems to contradict the above since ScanFind is activated only if the UPC code is not found in the products database:

[0110] In case of SKUs and SBCs, matching records would be found if valid SKUs or SBCs have been entered; and there is no question of ScanFind coming into operation. In case of UPC, the processes as described in previous paragraphs—since the ScanFind will be activated only if the UPC code were not found in the Products Database.

Claim 23, 28, 33 refer to "...wherein a product is not available if it is out of stock..." Not in stock is mentioned in para 0095, 0104, 0108, introduced in the instant application on 06/20/2001. The condition appears to refer to items that are not sold and that are sold out (para 0095).

Claims 21, 25, 30, 22, 27, 32, 24, 29 and 34 refer to "...receiving approval...from the customer...in response to the approval...approved product substitute..." It is not clear who is a customer that approve[-es] a substitute product. The claim language appears to exclude individual customers. Customer, Fig. 1, reference 103, appears as a variety of user (para 0010); there are also individual customers 241, corporate customers 203 (para 0033), customer users (para 0045), customer company employees (para 0073). Approval seems to exist only for corporate customers, as in para 0093, also added on 06/20/2001.

In Claims 20, 24, 25, 29, 30 and 34, the term "...in proximity..." and in claims 24, 29 and 34, the term "...degree of closeness..." render the claims indefinite:

...arranged such that each barcode of the plurality of barcodes is located in proximity of a product description of the plurality of product description which it identifies...

It is not clear whether applicant claims physical or logical relationships among the various data items. For purposes of examination, the term proximity is interpreted to include all physical and logical relationships among data items. The term ...degree of closeness... is interpreted as referring to a product that is related to a substitute product. Prior art is interpreted to meet the limitations where prior art discloses substitute products that are related to a desired product.

Claims 20, 25 and 30 contain 3 embedded conditional term ...based on whether... The term renders the claims indefinite, since it is not possible to determine the scope of the claim as requiring, for each conditional statement, both items or only one of the items separated by ...based on whether... For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

Claims 24, 29 and 34 add another conditional term ...if... The term renders the claims indefinite, since it is not possible to determine the scope of the claim as requiring both items or only one of the items separated by the if. For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

Claims 24, 29 and 34 refer to actions that take place after resolving 4 conditional statements. It is not clear what conditions are required to execute these actions.

Claims 24, 29 and 34 refer to code registry. Applicant discloses the use of external UPC registries and [internal] UPC databases (para 0103). It is not clear under what conditions the method of claim 20 can further comprise the steps of claim 24.

Claims 20, 25 and 30 refer to Product database which seems to refer to Fig. 1, item 109, of the aggregator website 105. para 0037. Applicant refers to Product database as products repository on the Aggregator website (para 0032, 0098), product repository (para 0094+), but appears to make a distinction in paragraph 0098. A database is any aggregation of data; a file consisting of a number of records of table, each of which is construction of fields (columns) of a particular type, together with a collection of operations that facilitate searching, sorting, recombination and similar activities.¹ MICROSOFT PRESS Computer Dictionary, 1993. For purposes of Examination, product database is interpreted to include aggregation(s) of data related to products. Prior art is interpreted to meet the limitations where prior art discloses data concerning products.

Claims 20, 25 and 30 refer to Product identifier which seems to refer to UPC, since applicant's invention is activated only if a UPC code is not found in the Products Database. See para 0110. For purposes of examination, the term is given its broadest reasonable interpretation to include UPC codes.

Claims 20-34 refer to Substitute table, which does not appear in the drawings, as noted above. Substitute table is introduced in para 0095 of the instant application. A table is a data structure. A table usually consists of a list of entries. Each entry is

¹ Definition of *database*, MICROSOFT Computer Dictionary, 1993.

identified by a unique key and contains related values. MICROSOFT PRESS Computer Dictionary. For purposes of examination, substitute table is interpreted to include data concerning substitute products.

Claim 20, 25 and 30 refer to actions that are implied, not positively recited and occur outside the metes and bounds of the claims. Thus the language carries little to no patentable weight. For example:

e ...in response to [???] a barcode of said plurality of barcodes in the
catalog being scanned by the customer...
I ...such that a future check of the substitute table for the first product
would indicate the approved substitute product...

Claims 20, 25 and 30 contain negative limitations embedded in conditional statements, rendering the claims indefinite. For example ...based on whether it is determined that said first product is not available...based on whether said first product is determined not to have a substitute product indicated in the substitute table...

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 20-34, as best understood and as interpreted, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,970,837) in view of Green (US 5,664,110).

As per claim 20, Walker discloses method(s) for managing scan-based input, comprising (the limitations are identified according to applicant's latest arguments)

a receiving a plurality of barcodes [images] at a server from a customer.
See, for example, at least Walker, col. 7, lines 56-67.

b resolving each of the plurality of barcodes [images] into a corresponding plurality of product identifiers, said plurality of product identifiers stored in a product database in communication with said server. See, for example, at least Walker, Col. 8, lines 1-30.

(c) catalog, as in list of product identifiers, Walker, Col. 29, lines 1-12.

for (c) and (d), see below

e receiving a selection of a first product in response to a barcode of said plurality of barcodes in the catalog being scanned by the customer. See, for example, at least Walker col. 7 lines 28-44; where a bar code identifies a product selected by a customer.

f determining whether said first product is available by querying said product database. See, for example, Walker col. 13 lines 8-20 and col. 20 lines 12-19; where a determination is made whether a first product is in stock, i.e. available.

g based on whether it is determined that said first product is not available by querying said product database, determining whether a substitute product is indicated in a substitute table. See, for example, Walker col. 13 lines 8-20 and col. 20 lines 12-19, where a substitute product is offered if the first product is not available; the substitute product is identified by a substitute product identifier; see interpretation of substitute table, under 35 USC 112.

h based on whether said first product is determined not to have a substitute product indicated in the substitute table, searching for at least one substitute product in the product database by comparing attributes of the first product to attributes of products in the product database. See, for example, at least Walker col. 13 lines 8-32 and col. 17 lines 17-29, where a substitute product is recommended to the buyer;

i based on whether at least one substitute product is found in the product database, sending the customer a recommendation of the at least one substitute product found in the product database. See, for example, Walker col. 17 lines 17-29; where a substitute product is recommended to the buyer.

J receiving approval indicating an approved substitute product selected from among the at least one substitute product found in the product database from the customer in response to the recommendation of the at least one substitute product found in the product database. See, for example, at least (see Walker col. 11 lines 55-67, col. 12 lines 56-65, col. 24 lines 34-50, col. 25 lines 14-36, and figure 11B; where approval from the customer in response to a substitute product offer is received.

k in response to the approval, saving the approved substitute product in a shopping cart of the customer and adding the approved substitute product to the substitute table such that a future check of the substitute table for the first product would indicate the approved substitute product. See, for example, at least Walker col. 11 lines 55-67, col. 12 lines 56-65, col. 24 lines 34-50, and col. 25 lines 14-36, where payment for the *substitute* product is collected; this is functionally the same as adding the *substitute* product to the shopping cart.

Walker **does not** disclose limitations (c) and (d):

(c) creating a catalog including the plurality of barcodes and a corresponding plurality of product descriptions arranged such that each barcode of the plurality of barcodes is located in proximity of a product description of the plurality of product descriptions which it identifies; (d) sending the catalog to the customer.

Green discloses limitations (c) and (d):

c creating a catalog including the plurality of barcodes and a corresponding plurality of product descriptions arranged such that each barcode of the plurality of barcodes is located in proximity of a product description of the plurality of product descriptions which it identifies. See, for example, at least Green **col.** 3 lines 5-21; where a catalog of bar codes is described.

(d) sending the catalog to the customer. See, for example, Green, **col.** 3 lines 5-21 and Figs. 2-4.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Walker to have included (c) and (d) as taught by Green because the incorporation of such features is no more than the predictable use of prior art elements according to their established function and because combining prior art elements according to known methods yield predictable results.

As per claim 21, Walker does not specifically disclose that sending the customer catalog to the customer comprises sending the customer a markup language file including the catalog.

As previously officially noticed, and now admitted prior art, it is old and well-known in the art to send a markup file with an attachment, such as a catalog, to a customer. A markup file includes commonly used markup files such as html files. The advantage of such a feature is that it facilitates delivery of marketing information to customers.

It would have been obvious, at the time of the invention, to one of ordinary skill in the art to modify Walker to disclose that sending the customer catalog to the customer comprises sending the customer a markup language file including the catalog because the incorporation of such features is no more than the predictable use of prior art elements according to their established function and because combining prior art elements according to known methods yield predictable results.

As for claim 22, Walker discloses calculating a degree of closeness between the approved substitute product and the first product; and storing the degree of closeness in the substitute table. See, for example, at least Walker figures 11-13, and related text concerning storing the degree of closeness in the substitute table.

As per claim 23, Walker discloses that a product is not available is if it is out of stock. See, for example, at least Walker **col.** 13 lines 8-20 and **col.** 20 lines 12-19; where a determination is made whether a first product is in stock.

As per claim 24, Walker discloses determining whether a particular barcode of the plurality of barcodes is stored in said product database. See, for example, at least Walker **col.** 7 lines 56-67 and **col.** 8 lines 1-30.

if the particular barcode is not stored in said product database, querying at least one code registry to locate a particular product substitute product. See, for example, at least Walker figures 11-13 and related text.

sending the customer a recommendation of the particular substitute product.
See, for example, Walker *col.* 13 lines 8-32 and *col.* 17 lines 17- 29).

receiving approval from the customer in response to the recommendation of the particular substitute product. See, for example, at least Walker, Fig. 11B.

in response to the approval from the customer in response to the recommendation of the particular substitute product, resolving the particular barcode into a product identifier of the particular substitute product. See, for example, at least Walker, Figs. 11-13.

Claim 25 is rejected on the same grounds as claim 20.

Claim 26 is rejected on the same grounds as claim 21.

Claim 27 is rejected on the same grounds as claim 22.

Claim 28 is rejected on the same grounds as claim 23.

Claim 29 is rejected on the same grounds as claim 24.

Claim 30 is rejected on the same grounds as claim 20.

Claim 31 is rejected on the same grounds as claim 21.

Claim 32 is rejected on the same grounds as claim 22.

Claim 33 is rejected on the same grounds as claim 23.

Claim 34 is rejected on the same grounds as claim 24.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
Primary Examiner
Art Unit 3625
15 March 2009